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OFFICE OF PETITIONS

In re Application of
Madanat & Girardet
Application No. 10/633,092
Filed: July 31, 2003
Attorney Docket No. NM-205
For: TRAFFIC SIGNAL ELECTRIC LAMP
ASSEMBLY

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed February 2, 2004 (certificate of mailing date January 29, 2004) and supplemented on August 2, 2004 (certificate of mailing date July 28, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 31, 2003 with a partially executed oath or declaration. On October 29, 2003, a Notice to File Missing Parts of Nonprovisional Application (Notice) was mailed. This Notice required petitioners to file a completely executed declaration, filing fees, a surcharge for their late filing, and omitted Figure 4C within two months of the mail date of the Notice. Extensions of time under 37 CFR 1.136(a) were available.

In response, on February 2, 2004 (certificate of mailing date January 29, 2004), a petition for a one month extension of time and required fee, the surcharge, and the instant petition were filed.

A statement of facts of Attorney Ray K. Shahani was part of the petition. Attorney Shahani establishes that the non-signing inventor, Brian R. Girardet, was mailed the application papers,

including the specification, claims and drawings; however, Mr. Girardet's attorney informed Attorney Shahani that Mr. Girardet would not sign the declaration and other documents during an August 18, 2003 conversation.

The October 29, 2003 Notice was later withdrawn and replaced by the April 21, 2004 Notice. The requirement for a completely executed declaration was reiterated in the April 21, 2004 Notice.¹ Petitioner timely resubmitted the instant petition on August 2, 2004 (certificate of mailing date July 28, 2004). The February 2, 2004 (certificate of mailing date January 29, 2004) Rule 47 petition was **not** accompanied by the required petition fee. A petition is not properly filed until a petition fee is received. Since the August 2, 2004 (certificate of mailing date July 28, 2004) petition contained an authorization to charge any additional fees due to petitioner's deposit account, the petition fee was authorized at that time. Deposit account no. 50-3056 will be charged the \$130.00 Rule 47 petition fee.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. The declaration presented on July 31, 2003 lists each inventor's name, address, and citizenship. A declaration must contain each applicant's place of residence, as well. MPEP 605.01 In addition, the Office would like petitioner to refrain from using the term "ADDRESS" in the declaration and instead term it "MAILING ADDRESS." Effective November 7, 2000, 37 CFR 1.63 was amended to use the term "mailing address" rather than "post office address." Since petitioner knows the application's serial number and filing date, that information should be included on the new declaration, also.

An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of Mr. Girardet is REQUIRED. See MPEP 409.03(a).

¹ While it is not the undersigned's task to review Notices for accuracy, the undersigned has noted that the later Notice does not address omitted Figure 4C. Figure 4C is cited in the specification, but it appears that Figure 4C is **not** present among the drawing figures. Petitioner may wish to clarify this issue prior to first action on the merits.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries should be directed to the undersigned at (571) 272-3230.



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